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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,570	07/27/2001	Robert S. Zeller	0046.1059-006	2030

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/916,570

Applicant(s)

VROMAN ET AL.

Examiner

George P Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election of the metal powder species (species "a" of the restriction requirement mailed September 6, 2002) is acknowledged. Claims 16 and 17 are withdrawn from consideration as being drawn to a non-elected species.
2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim contains an improper Markush group. The examiner suggests inserting --a metal selected from the group consisting of-- after the word "comprises" in line 1 of this claim.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-5, 7-15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahslund et al. (U.S. Patent 4,435,483).

Ahslund discloses a stainless steel powder which appears to be present in an irregular morphology resulting from the consolidation of smaller particles of such a powder; see Figure 3 of Ahslund. The Ahslund powder is quite porous and therefore would have an air laid density lower than that of individual particles of such a powder. Ahslund does not specify the process steps recited in product-by-process terms in the instant claims. However, it is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product

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substantially the same as that being claimed, differing only in the manner by which it is made, the burden falls to applicant to show that any process steps associated therewith result in a product materially different from that disclosed in the prior art. See *In re Brown* (173 USPQ 685) and *In re Fessman* (180 USPQ 524). In the present case, Applicant has not met this burden. Thus, the Ahslund et al. disclosure is held to create a prima facie case of obviousness of the presently claimed invention.

5. Claims 1-10, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (U.S. Patent 5,409,520).

Mori discloses a copper powder of irregular morphology defined by Mori as "green caterpillar-like crystals". From the drawing figures of Mori, it appears that the prior art powder meets the physical limitations defined in the instant claims. This powder is obtained from a starting material that is dendritic, as opposed to non-dendritic in the instant claims. However, the instant claims recite this limitation, as well as all of the other process limitations in the instant claims, in product-by-process terms. Given that the physical form of the powder of Mori appears to be the same as that of the final powder product as defined in the instant claims, the burden falls to Applicant to show that any process limitations result in a patentably distinct product from that of the prior art, for reasons as stated in item no. 4 supra. Consequently, a prima facie case of obviousness is established between the disclosure of Mori et al. and the presently claimed invention.

6. Claims 1-15, 18 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,193,778. Claims 1-15, 18 and 19 are also provisionally rejected under the

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judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/ 724,147 (which claims have been indicated allowable in the Notice of Allowability mailed November 27, 2002).

With respect to the '147 claims, this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, as well as the '778 claims and the pending '147 claims, are all drawn to metal powders having substantially the same physical form and made by substantially identical methods. The conflicting claims define essentially an embodiment of the present invention in which the metal is chromium. With respect to instant claims 13 and 19 which recite "stainless steel", this limitation would fall within the scope of the "alloy of chromium" as recited in '778 claim 2. Because of the overlapping subject matter of the various sets of claims, no patentable distinction is seen between the invention as defined by the instant claims, and that as defined by the '778 claim or the pending '147 claims.

7. Claims 1-10, 15 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,193,085. Claims 1-10, 15 and 18 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/ 724,148. With respect to the '148 claims, this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims, as well as the '085 claims and the pending '148 claims, are all drawn to metal powders having substantially the same physical form and made by substantially identical methods. The conflicting claims define essentially an embodiment of the present invention in which the metal is titanium. Because of the overlapping subject matter of the various sets of claims, no patentable distinction is seen between the invention as defined by the instant claims, and that as defined by the '085 claim or the pending '148 claims.


8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310 for all correspondence except for After Final amendments in which case the Fax number is (703) 872-9311. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

GPW
December 19, 2002


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER